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DARBY & DARBY P.C. P.O. BOX 770 Church Street Station New York, NY 10008-0770			ALVAREZ, RAQUEL	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ANAND SUBRAMANIAN,
JEREMY STERNS, and
SHANTHINI RAJENDRAM

Appeal 2010-002280
Application 10/001,772
Technology Center 3600

Before HUBERT C. LORIN, JEAN R. HOMERE, and
BIBHU R. MOHANTY, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL¹

An oral hearing was held on Sep. 14, 2010.

¹The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

Anand Subramanian, et al. (Appellants) seek our review under 35 U.S.C. § 134 of the final rejection of claims 15, 16, 21, 22, and 27-89. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We AFFIRM-IN-PART.²

THE INVENTION

The invention relates “generally to providing content, services and advertising about services by means of the Internet and, more particularly, to bringing to customers various services, content, advertising about services and affiliate links that are automatically determined to be relevant to the customer’s current interest on the Internet.” Specification 1:17 -2:2.

Claim 15, reproduced below, is illustrative of the subject matter on appeal.

15. A system for delivering ads to a user viewing content operating a station connected to a distributed computer network, comprising:
- an ad server which maintains the ads for the user at the station across the distributed computer network, the user station allowing the user to retrieve information containing content;
 - a data store containing a set of relevancy rules associated with each ad, the rules being operable to indicate a level of relevancy of the ad to the content of the information retrieved; and

² Our decision will make reference to the Appellants’ Appeal Brief (“App. Br.,” filed Aug. 5, 2009) and Reply Brief (“Reply Br.,” filed Oct. 2, 2009), and the Examiner’s Answer (“Answer,” mailed Aug. 27, 2009).

a match maker configured to, in response to the submission of a URL by the user at the operating station, access the content retrieved by the user, extract the content according to extracting rules, parse the content of the information into objects, target an ad from the server to the content by applying the relevancy rules in the data store to the objects, free of information about the user, and directly send the targeted ad to the station for display with the content.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Emens	US 7,076,443	Jul. 11, 2006
Herz	US 5,835,087	Nov. 10, 1998

The following rejections are before us for review:

1. Claims 15, 16, 21, 22, 27-89 are rejected under 35 U.S.C. §103(a) as being unpatentable over Emens and Herz.

ISSUES

The major issue is whether the prior art combination discloses or would lead one of ordinary skill in the art to a system and method for delivering ads to a user viewing content as claimed.

FINDINGS OF FACT

We rely on the Examiner's factual findings stated in the Answer (Answer 3-4) and add the following.

There is no dispute that Emens discloses product icons for display with search results. *See* col. 7, ll. 11-31. There is also no dispute that, when one of the Emen's displayed product icons are selected, a user is routed to a product presentation. Col. 7, ll. 28-31.

The claims call for targeted advertisements for display with content. The claims do not specify a form for the advertisements. The Specification indicates that the advertisements may be in the form of a hyperlink (Specification 21:19-20 discussing Fig. 7) and/or an icon (Specification 34:16-20, discussing Fig. 16).

ANALYSIS

According to the Appellants, “the Emens system is *incapable of displaying an advertisement and content at the same time.*” Reply Br. 2 (emphasis original). *See also* App. Br. 7 (“Point 1”). The Appellants acknowledge that Emens discloses displaying a product icon and content (i.e., search results) but “Emens clearly distinguishes the icon or link for requesting one or more advertisements from the advertisement that is provided after the user selects the icon or link” (App. Br. 7).

We do not find the Appellants’ argument persuasive. The claims do not limit the form of the advertisement. The advertisement as claimed covers icons. *See* the Specification. Thus the only difference between the claimed subject matter and that of Emens is the content of the icon. Assuming that the content of Emens product icon is not for the purpose of advertising, the difference between an icon that advertises (as would be the case for the claimed subject matter) and an icon that is indicative of a product (Emens) is a distinction over the content of the information on the icon, that is, descriptive material. Patentable weight need not be given to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate (here the system). *See In re Lowry*, 32 F.3d 1579, 1582-83 (Fed. Cir. 1994); *In re Ngai*, 367 F.3d

1336, 1338 (Fed. Cir. 2004). In that regard, the Appellants have not come forward with evidence sufficient to show that the structure of the system is functionally affected by an icon having an advertising purpose as opposed to identifying a product (as in *Emens*). Absent such evidence, it is reasonable to conclude that the claim limitation of displaying an advertisement, in the form of an icon, is descriptive and not functionally related to any structure of the claimed system and as such falls under the category of patentably inconsequential subject matter. *See Ex parte Curry*, 84 USPQ2d 1272, 1275 (BPAI 2005) (informative) (“Common situations involving nonfunctional descriptive material are: - a computer-readable storage medium that differs from the prior art solely with respect to nonfunctional descriptive material, such as music or a literary work, encoded on the medium, - a computer that differs from the prior art solely with respect to nonfunctional descriptive material that cannot alter how the machine functions (*i.e.*, the descriptive material does not reconfigure the computer), or - a process that differs from the prior art only with respect to nonfunctional descriptive material that cannot alter how the process steps are to be performed to achieve the utility of the invention.

Thus, if the prior art suggests storing a song on a disk, merely choosing a particular song to store on the disk would be presumed to be well within the level of ordinary skill in the art at the time the invention was made. The difference between the prior art and the claimed invention is simply a rearrangement of nonfunctional descriptive material.).” *See also Ex parte Mathias*, 84 USPQ2d 1276, 1278 (BPAI 2005) (informative). Nonfunctional descriptive material cannot render nonobvious an invention that would have otherwise been obvious. *In re Ngai*, 367 F.3d at 1339. *Cf.*

In re Gulack, 703 F.2d 1381, 1385 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability).

The Appellants also challenge the relevance of Herz in showing the obviousness of the claimed invention. App. Br. 10-12 (“Point 2”). According to the Appellants, the cited art combination would not suggest “URL submissions for content.” App. Br. 12. We understand the Examiner to have applied Herz to show accessing content via a URL. But Emens nevertheless teaches searching over the Internet. *See* col. 4, ll. 54-67. To one of ordinary skill in the art this would suggest submitting a URL, otherwise one would be unable to retrieve search results over the Internet. Accordingly, we disagree with the Appellants that one of ordinary skill in the art having these references in hand would not be led to a system whereby a user retrieves content via submission of a URL.

The Appellants also challenge the rejection on the grounds that the prior art combination fails to lead one to deliver advertisements to a user viewing content as claimed. App. Br. 12-13 (“Point 3”). This challenge is based on the same argument discussed earlier with regard to the argument that the Emens system is incapable of displaying an advertisement and content at the same time. For the same reasons, we find the argument unpersuasive.

We have reviewed the arguments but do not find that they overcome the *prima facie* case of obviousness for the subject matter of claims 15, 16, 21, 22, 27-35, and 37-89 over Emens and Herz.

Re claim 36, it further limits the system of claim 1 such that the extracting rules enable a classification of content according to specific type

of channel (claim 35) related to past consumption by users as a consequence of ads that were received and responded to by them. The Examiner has argued that this claimed subject matter was old and well known. Answer 4. The Appellants seasonably requested evidence in support thereof while casting reasonable doubt on the conventionality of providing a classifying channel related to past consumption by users as a consequence of ads that were received and responded to by them. *See e.g.*, Remarks filed Apr. 27, 2009. No evidence has been provided however. Nevertheless, no apparent reasoning with logical underpinning has been provided (except that classifying information based on past consumption was well known) to explain how one of ordinary skill in the art would have reached the claimed invention given this allegedly well known knowledge and that the cited prior art would lead one to display results and associated product icons. Accordingly, we do not find that a prima facie case of obviousness has been made out for claim 36 in the first instance.

DECISION

The decision of the Examiner to reject claims 15, 16, 21, 22, 27-35, and 37- 89 under 35 U.S.C. §103(a) as being unpatentable over Emens and Herz is affirmed. The rejection of claim 36 under 35 U.S.C. §103(a) as being unpatentable over Emens and Herz is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED-IN-PART

mev

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